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REMARKS

The Examiner has rejected Claims 1-42, and 43 under 35 U.S.C. 102(e) as being anticipated by Alam et al. (U.S. Pat. No.: 6,336,124). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove. Specifically, applicant has amended each of the independent claims to include the subject matter (or substantially similar, but not identical subject matter) of Claim 10 et al.

In the Examiner's action, the Examiner relies on the following excerpt from Alam to meet applicant's claimed "converting the electronic file from a first file format to a second file format that is different from the first file format and that prevents a computer virus in the electronic file from executing when the converted electronic file is opened by the intended recipient."

"If no virus is detected or if a virus is detected and removed, step 2508 determines if the input document is in a supported format. If the input document is not in a supported format, process 2500 ends. If the input document is in a supported format, the input document is converted to an intermediate format document at step 2510. The intermediate format document is in turn converted to an output format document at step 2512. This conversion process may be as described above, including reformatting as necessary or as requested such that a single page of the input document may be separated into multiple display pages." (see col. 20, lines 22-32)

Applicant respectfully disagrees with this assertion. In particular, the foregoing excerpt merely suggests the conversion of a format document for non-security-related purposes, namely based on what type(s) of format is supported. In sharp contrast, applicant teaches and claims converting the electronic file to a second file format that is different from the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient. Only applicant teaches and claims such a specific conversion that meets the particular functionality of preventing the computer virus from executing when the converted electronic file is opened by the intended recipient, as claimed.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051,

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1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the Alam reference, for the reasons noted above. Nevertheless, despite the foregoing paramount difference and in the spirit of expediting the prosecution of the present application, applicant has amended each of the independent claims to include the following subject matter (or substantially similar, but not identical subject matter) of Claim 10 et al.:

“said converting of the electronic file being in response to a determination that the electronic file represents the potential security risk to the computer system.”

The Examiner fails to even make a specific prior art citation regarding the above subject matter from former Claim 10. It is clear that Alam fails to even suggest, in combination with the remaining claimed features, a technique for providing the aforementioned conversion under a particular condition, namely if the certain electronic file is determined to be infected.

A notice of allowance or a specific prior art showing of all of applicant’s claim limitations, in combination with the remaining claim elements, is respectfully requested.

With respect to the dependent claims, applicant has carefully reviewed the excerpts relied upon by the Examiner to reject the same, and has found serious deficiencies in the Examiner’s application of the prior art.

Just by way of example, the Examiner relies on the following excerpt from Alam to meet applicant’s claimed “receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus; converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient” (see Claim 21). It is noted that the Examiner fails to even make a specific prior art citation regarding the above subject matter.

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Still yet, the Examiner relies on the following excerpt from Alam to meet applicant's claimed "the second file format being a HTML file format without scripts" (see Claim 5 et al.).

"The input and output formats may be, for example, portable document format (PDF), rich text format (RTF), hypertext markup language (HTML) format with style sheets, tabular HTML, extensible markup language (XML), cascading style sheets (CSS), Netscape Layers, linked and separate pages, Tag Image File Format (TIFF) or any other image format such as graphics interchange format (GIF), bit map (BMP), or Joint Photographic Experts Group (JPEG), formats generated by text and/or image authoring tools or applications, or any other suitable formats." (see col. 2, lines 1-10)

Such excerpt and the remaining Alam reference, however, merely suggest conversion to and from a HTML file format. There is simply not even a suggestion of any sort of conversion to a second file format being HTML file format without scripts, which is particularly suited for security purposes.

Again notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NAI1P091/01.049.01).

Respectfully submitted,
By: _____
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